

### **REMARKS**

This is in response to the Office Action mailed July 10, 2009. Claims 1-4, 9-30, 35-36, 38-49, 51, 56-58, 64-67, and 69-70 are pending. Claims 5-8, 31-34, 37, 50, 52-55, 59-63, and 68 have been cancelled. Claim 2 is amended in order to correct a typo changing “either” to “ether.” No new matter has been added with the present amendment.

Applicants have corrected the claim identifiers of claims 12 and 13 to read, “Previously presented.” Applicants thank the Examiner for bringing this inaccuracy to their attention.

#### **Rejections Under 35 U.S.C. §103(a)**

*Theyssen (U.S. Pat. No. 5,935,914) in view of Li (U.S. Pat. No. 6,214,777) and Zeman (U.S. Pat. No. 6,458,343)*

The Examiner has rejected claims 1-4, 15-18, 26-30, 39, 40, 42-49, 51, 57, 58, 64, 66, 67 and 69 under 35 U.S.C. 103(a) as being unpatentable over Theyssen (U.S. Pat. No. 5,935,914) in view of Li (U.S. Pat. No. 6,214,777) and Zeman (U.S. Pat. No. 6,458,343).

The Office relied upon Theyssen as disclosing a lubricant concentrate comprising an ether carboxylate. However, the Office conceded that Theyssen did not specifically disclose a C<sub>9</sub>-C<sub>11</sub> propoxylated alcohol. Li was cited as teaching ethoxylated alcohols are preferred but the Office argued that the disclosure is broad enough to encompass propoxylated alcohols. Zeman was cited as teaching that alkoxylated alcohols are typical and commonly known antifoaming agents and it would have been obvious to utilize an alkoxylated alcohol which encompasses propoxylated alcohols of Theyssen to obtain the advantageous antifoaming characteristics disclosed by Zeman. Applicants respectfully traverse this rejection.

First, the Examiner’s statement that alkoxylated alcohols encompass propoxylated alcohols is incorrect. When a skilled artisan speaks of alkoxylated alcohols, the alcohols include

*both* propoxyl *and* ethoxyl groups. (See Declaration of Richard O. Ruhr dated April 29, 2009 Paragraph 5). To state that disclosure of alkoxylated alcohols also teaches disclosure of propoxylated alcohols is simply not true.

Second, Applicants disagree with the Examiner's statement that they have not shown criticality for C<sub>9</sub>-C<sub>11</sub> propoxylated alcohols. The Examiner argued that because Applicants' Comparative Example L does not include an ethoxylated alcohol as disclosed in Li, it does not compare the closest prior art against the claimed subject matter. Applicants respectfully disagree. Ethoxylated alcohols as disclosed in Li are commonly known as *foaming agents* by persons having ordinary skill in the art. Adding an ethoxylated alcohol to Applicants' invention would be counter productive because it would teach away from Applicants' goal of a low foaming lubricant. Adding an ethoxylated alcohol to Applicants' invention would result in a higher foaming composition. In fact, contrary to the Examiner's contention, Applicants have compared the closest art against their claimed invention when they prepared Comparative Composition L because an ethoxylated propoxylated alcohol would serve to provide the next lowest foaming composition (of which Applicants are aware) as compared to Applicants' claimed propoxylated alcohol containing composition. Comparison of what the Examiner has requested, Applicants' claimed propoxylated alcohol against a composition having an ethoxylated alcohol, would only demonstrate what skilled artisans already know. That is, an ethoxylated alcohol-containing composition produces much more initial foam and more foam after 5 minutes has elapsed than Applicants' propoxylated alcohol-containing composition.

Third, the Examiner further contested that since Comparative Example L includes various surfactants not found in the prior art of record the Affidavit of Richard O. Ruhr does not compare the closest prior art of record. Applicants are surprised by this statement. Failure to include the

various surfactants of Applicants' Example 1 would not allow an apples to apples comparison of the two compositions. If the surfactants were included in Example 1 but were then stripped from Comparative Example L the Examiner would likely (but wrongly) argue that the surfactants provided the low foaming performance objectives.

Fourth and finally, Applicants are perplexed by the Examiner's statement that Comparative Example L has a reduced initial and 5 minute foam. Applicants direct the Examiner's attention to Table 10 found on page 23 of the specification at lines 6-8. The Initial Foam of Comparative Example L is 310 mls which is substantially greater than the Initial Foam of Example 1 which is 295 mls. When comparing the 5 minute foam data, Comparative Example L had a foam level of 305 mls which again was substantially greater than that of Example 1 which had 280 mls. Contrary to the Examiner's statement, Comparative Example L *does* teach away from the superior lower foaming compositions of the invention.

Applicants have shown the criticality of their claimed components. In other words, they have demonstrated unexpected results. Additionally, Applicants have also demonstrated why the cited references fail to teach their invention. Since a reference teaching alkoxyated alcohols does not *inter alia* teach propoxylated alcohols, the Examiner has made an unacceptable leap in reaching Applicants' claimed invention. As such, Theyssen, Li, and Zeman fail to teach or suggest the particular propoxylated alcohol providing Applicants' low foaming lubricant composition. The cited references do not render Applicants' claims obvious and Applicants respectfully request withdrawal of the §103 rejection based upon Theyssen, Li, and Zeman.

*Theyssen (U.S. Pat. No. 5,935,914) in view of Li (U.S. Pat. No. 6,214,777) and Zeman (U.S. Pat. No. 6,458,343) and further in view of Person Hei (US 5,723,418)*

The Examiner rejected claims 19-24, 41, 56, 65 and 70 under 35 U.S.C. 103(a) as being unpatentable over Theyssen (U.S. Pat. No. 5,935,914) in view of Li (U.S. Pat. No. 6,214,777) and Zeman (U.S. Pat. No. 6,458,343) and further in view of Person Hei (U.S. Pat. No. 5,723,418). Applicants traverse the rejection. Person Hei fails to overcome the deficiencies addressed above with respect to Theyssen, Li and Zeman. Particularly, the cited references do not expressly teach a lubricant comprising a C<sub>9</sub> to C<sub>11</sub> propoxylated alcohol. The use of a C<sub>9</sub> to C<sub>11</sub> propoxylated alcohol produces unexpected results as supported by the Affidavit of Richard O. Ruhr submitted April 30, 2009. The claims are therefore not obvious over the cited art and Applicants request a withdrawal of the present rejection.

*Theyssen (U.S. Pat. No. 5,935,914) in view of Li (U.S. Pat. No. 6,214,777) and Zeman (U.S. Pat. No. 6,458,343) and Person Hei (US 5,723,418) and further in view of Login (U.S. Pat. No. 4,395,373)*

The Examiner rejected claim 25 under 35 U.S.C. 103(a) as being unpatentable over Theyssen (U.S. Pat. No. 5,935,914) in view of Li (U.S. Pat. No. 6,214,777), Zeman (U.S. Pat. No. 6,458,343) and Person Hei (U.S. Pat. No. 5,723,418) and further in view of Login (U.S. Pat. No. 4,395,373). Applicants respectfully traverse the rejection. Applicants' arguments made above with respect to the prior rejections apply here as well. In particular, Login fails to overcome the deficiencies recited above. That is, the cited references do not expressly teach a lubricant comprising a C<sub>9</sub> to C<sub>11</sub> propoxylated alcohol. As demonstrated and previously discussed, the use of a C<sub>9</sub> to C<sub>11</sub> propoxylated alcohol produces unexpected results. Therefore the claims are not obvious over the cited art and withdrawal of the obviousness rejection is earnestly solicited.

## **Summary**

It is respectfully submitted that each of the pending claims is in condition for allowance, and notification to that effect is kindly requested. The Examiner is invited to contact the Applicants' primary attorney-of-record, Amy J. Hoffman, at (651) 795-5852, if it is believed that prosecution of this application may be assisted thereby.



Respectfully submitted,

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